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08/027-870 APPLICATION NO.	08/22/98 FILING DATE/98	TOJO FIRST NAMED INVENTOR	11 ATTORNEY DOCKET NO. SKU-104-A-1
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QM21/0422

EXAMINER GORSKI, J

ART UNIT 3725	PAPER NUMBER 11
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DATE MAILED:

08/22/98

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087627.270	04/04/96	TOJO H	SKO-104-A-1

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EXAMINER
GORSKI, J

ART UNIT	PAPER NUMBER
3726	

DATE MAILED: 07/08/98

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.

627270

Applicant(s)

TOSJO et al.

Examiner

GORSKI

Group Art Unit

3206

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/17/98
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 14-16, 19, 20, 26, 27 and 30-37 is/are pending in the application.
- Of the above claim(s) 14-16, 19 and 34-36 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 20, 26, 27, 30-33 and 37 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 14-16, 19 and 34-36 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The restriction requirement of paper #3 is hereby maintained. Accordingly, claims 14-16, 19 and 34-36 remain withdrawn from further consideration as being drawn to a non-elected invention.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 20, 26, 27, 30-33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art as described in the specification in view of Tomioka et al.

Applicant is referred to paragraph #4 of the Office action of 9/4/97, paper #7.

4. Applicants' arguments have been considered but are not deemed persuasive. Applicant argues that the proposed combination of references is based on impermissible hindsight, and not any teaching or suggestion which may be fairly gleaned from the prior art. However, Applicants' admitted prior art discloses that it is known to paint an automobile by applying both a first coat thereto and then a strippable paint thereto, and Tomioka et al. explains benefits of assembling an automobile after the painting thereof has been completed. Accordingly, in order to realize the benefits taught by Tomioka et al., one having ordinary skill in the art would have found it obvious to modify Applicants' admitted prior by assembling the automobile thereof after it has been

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painted. Thus, the motivation to combine the references comes solely from the teachings thereof, and not from Applicants' disclosure.

Applicant also argues that the instant invention overcomes a disadvantage of the prior art, which is the use of an anti-scratch cover. Applicant is requested to elaborate as to why this is so, especially in light of the fact that the claims fail to define the function that the strippable paint is to perform. Also, the claims do not preclude the use of an anti-scratch cover.

Regarding the "stabilizing", "preliminarily drying" and "non-preliminarily drying" steps, Applicant is requested to explain the significance of these steps relative to the "mere drying" of a strippable paint as described in the Background section of the specification.

5. In response to this Office action, Applicant is requested to elaborate on lines 7-8, page 2 of the specification. Namely, are the small parts assembled after they have been coated with the strippable paint?

Also, Applicant is requested to submit any information of which Applicant is aware pertaining to the "stabilizing", "preliminary drying" and "non-preliminary drying" of a coating, in order that a complete and thorough examination of this application can be made.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

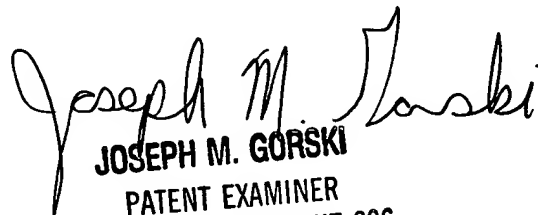
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication should be directed to Joseph Gorski at telephone number (703) 308-1805.

Gorski/DMM

April 20, 1998


JOSEPH M. GORSKI
PATENT EXAMINER
GROUP 320 - ART UNIT 326